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PATENT
930025-2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s)	:	Victor P. Laskorski
U.S. Serial No.	:	10/039,511
Filed	:	January 4, 2002
For	:	**INSULATION MATERIAL**
Examiner	:	Alexander S. Thomas
Group Art Unit	:	1772
Confirmation No.	:	

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APPEAL BRIEF OF APPELLANT

Mail Stop Appeal Briefs-Patents
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Sir:

This is an Appeal from the Final Rejection by the Examiner dated February 24, 2004, which issued in the above-identified application, finally rejecting claims 1,2, and 5-14. A Notice of Appeal was filed on June 9, 2004. This Brief is submitted in triplicate as required by 37 C.F.R. §1.192(a) and is accompanied by the requisite fee set forth in 37 C.F.R. §1.17(f). The

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Assistant Commissioner is authorized to charge any additional fee, or credit any overpayment, to Deposit Account No. 50-0320.

REAL PARTY IN INTEREST

The real party in interest is Albany International Corp., 1373 Broadway, Albany, New York 12204, to which Appellant has assigned all interest in this application.

RELATED APPEALS AND INTERFERENCES

Upon information and belief, the undersigned attorney does not believe that there is any appeal or interference that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

REQUEST FOR AN ORAL HEARING

An oral hearing is requested.

STATUS OF THE CLAIMS

The Application was filed with claims 1-14 on January 4, 2002, and assigned Application Serial No. 10/039,511.

In a first Office Action dated February 28, 2003, the Examiner rejected claims 1-4 and 11 under 35 U.S.C. §102(b) as allegedly anticipated by PCT Application No. WO 00/06379. The Examiner also rejected claims 1-9 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 3,660,215 to Pawlicki. The Examiner further claims 1-7 and 11 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 3,629,047 to Davidson. In addition, the Examiner rejected claims 10-14 under 35 U.S.C. § 103(a) as unpatentable over Pawlicki.

Finally, the Examiner rejected claims 5, 8-10 and 12-14 35 U.S.C. § 103(a) as allegedly unpatentable over PCT Application WO/0006379.

In response to this first Office Action, Appellant filed an Amendment on May 28, 2003, amending claims 1, 3, and 4, and arguing against the rejections.

The Examiner then issued a Final Office Action on June 20, 2003. The Examiner rejected claims 1, 2, and 11 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,033,135 to Creek. The Examiner also rejected claims 1-4 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 3,562,082 to Buskirk. Claims 5-10 and 12-14 were objected to as dependent from a rejected base claim but would have been allowable if rewritten in independent form.

In response to the Final Office Action, Appellant filed an Amendment on September 4, 2003 amending claims 1 and 5 and arguing against the rejections.

The Examiner issued an Advisory Action on September 24, 2003 stating that the proposed amendment to the claims allegedly raised new issues that would require further consideration.

In response, Applicant filed a Request for Continued Examination on October 17, 2003 requesting the Examiner to consider the amendments previously filed on September 4, 2003.

The Examiner issued an Office Action on November 6, 2003 objecting to claims 1-4 and 11 for alleged informalities. The Office Action also rejected claims 1 and 2 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,769,267 to Hoyt. The Office Action also rejected claims 1, 2, 5-7, and 11 as allegedly anticipated by U.S. Published Patent Application No. 2002/0164465 to Curro et al. Finally, the Office Action rejected claims 8-10 and 12-14 as allegedly unpatentable over Curro et al.

In response to this Office Action, Appellant filed an Amendment on January 26, 2004, amending claims 1 and 5 and arguing against the rejections.

The Examiner issued a Final Office Action on February 24, 2004. In the Final Office Action the Examiner maintained the rejection of claims 1 and 2 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,769,267 to Hoyt. The Final Office Action also maintained the rejection of claims 1, 2, 5-7, and 11 as allegedly anticipated by U.S. Published Patent Application No. 2002/0164465 to Curro et al. The Final Office Action further maintained the rejection of claims 8-10 and 12-14 as allegedly unpatentable over Curro et al. Claims 3 and 4 were objected to as dependent from a rejected base claim but would have been allowable if rewritten in independent form.

A response to the Final Office Action was filed by the Appellant on May 21, 2004 arguing against the rejections.

An Advisory Action was issued by the Examiner on June 3, 2004 maintaining the rejections from the Final Office Action.

A Notice of Appeal was filed by Appellant on June 9, 2004, from which this Appeal Brief is being filed.

Accordingly, the status of the claims may be summarized as follows:

Claims Allowed:	None.
Claims Objected to:	3 and 4
Claims Rejected:	1, 2, 5-14.

STATUS OF THE AMENDMENTS

Appellant believes that all the submitted Amendments have been entered.

SUMMARY OF THE INVENTION

The present invention is directed to a novel structure for spacing layers of insular batt.

ISSUES PRESENTED

1. Whether claims 1 and 2 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,769,267 to Hoyt.
2. Whether claims 1, 2, 5-7, and 11 are anticipated by U.S. Published Patent Application No. 2002/0164465 to Curro et al.
3. Whether claims 8-10 and 12-14 are unpatentable under 35 U.S.C. § 103(a) over U.S. Published Patent Application No. 2002/0164465 to Curro et al.

GROUPING OF CLAIMS

For purposes of this appeal, claims 1, 2, and 5-14 constitute one group and stand or fall together.

ARGUMENTS

Claims 1, 2, and 5-14 were improperly rejected as being anticipated under 35 U.S.C. §§ 102(b) and 102(e) and as unpatentable under 35 U.S.C. §103(a).

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Hoyt; claims 1, 2, 5-7 and 11 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Curro; and claims 8-10 and 12-14 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Curro. It is respectfully submitted that none of the cited documents teach, enable, suggest or motivate a skilled artisan to practice the instantly claimed invention.

The instant invention is directed to an insulation material, such as thermally insulating material in sleeping bags and other items. None of the references relied upon by the Office Action, however, provide for an insulation material as instantly claimed.

Hoyt's chamois is not an insulation material. The chamois is merely a drying rag for windows and glass, automobile and marine bodies, and household surfaces. Similarly, Curro's laminate web is not insulation material. The laminate is a clean room wipe, tack cloth, decorative covering, or a food pad. In addition, Curro's laminate web is said to be conductive (paragraph 151, page 15) and is, therefore, by definition not an insulation material.

Applicants also respectfully object to the allegations that the instantly claimed insulation material is "inherently" taught by either Hoyt or Curro. More specifically, the Examiner's sweeping allegation that "any article, such as those disclosed in the reference, possesses insulating properties to a degree, whether they be heat, sound, electrical, etc. insulting properties" is not an adequate basis for rejecting the instant claims.

The Examiner is respectfully reminded that it is not enough to merely allege that because a document purportedly recites disparate materials that the document must "inherently" speak to the instantly claimed invention. Instead, the document must disclose or suggest the properties of the claimed invention for inherency to attach. According to *In re Rijckaert*, 9 F.3d 1531, 1957 (Fed. Cir. 1993), "such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection." The Federal Circuit is clear that " 'inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency].' " *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed. Cir. 1991), *citing to In re Oelrich*, 666 F.2d 578, 581-582 (C.C.P.A. 1981). Indeed, "before a

reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference." *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corporation*, 31 F.3d 1177 (Fed. Cir. 1994) (emphasis in original).

Against this background, as the cited documents do not disclose nor suggest the elements and properties of the claimed invention, the Section 102 rejections must fail as a matter of law.

Turning to the Section 103 rejections, the Examiner has not provided a reason why a skilled artisan would be led to practice the instantly claimed invention in light of the cited document. Instead, the Examiner appears to suggest that simply because Curro is arguably analogous art, the instant invention would somehow naturally arise therefrom. This is not the standard by which to gauge patentability.

Instead, for the Section 103(a) rejection to be proper, both the suggestion and the expectation of success must be found in the prior art, and not in Applicants' own disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Indeed, hindsight based on Applicants' own success as disclosed and claimed in the present application, is not a justifiable basis on which to contend that the ultimate achievement of the present invention would have been obvious at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1599, 1600 (Fed. Cir. 1988).

Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. Id. And as "obvious to try" would be the only standard that would lend the Section 103 rejections any viability, the rejections are fatally defective and should be removed.

Accordingly, for at least the reasons described above, the documents cited by the Examiner fail to render claims 8-10 and 12-14 unpatentable under 35 U.S.C. §103(a). Therefore, the rejected claims should be allowed.

CONCLUSION

For the reasons discussed above, claims 1-14 are patentable. It is, therefore, respectfully submitted that the Examiner erred in rejecting claims 1,2, and 5-14, and a reversal by the Board is solicited.

Respectfully submitted,

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APPENDIX

CLAIMS ON APPEAL

1. (Amended) An insulation material comprising:

a first layer of material of somewhat uniform thickness;

a second layer of material of somewhat uniform thickness for positioning over said first layer;

inserts for insertion between said first layer and said second layer, said inserts being compressible and having interior voids, and said layers being in contact with each other along one or more portions thereof where the inserts are not located; and

means for affixing said first layer and said second layer together whilst securing the inserts therebetween.

2. (Original) The insulation material in accordance with claim 1 wherein said means for affixing includes thermo bonding, thermo setting, gluing, stitching or needling.

3. (Amended) The insulation material in accordance with claim 2 wherein said inserts are a helix.

4. (Amended) The insulation material in accordance with claim 1 wherein said inserts are a helix.

5. (Amended) An insulation material comprising:

a first layer of material of somewhat uniform thickness;

a second layer of material of somewhat uniform thickness for positioning over said first layer;

inserts for insertion between said first layer and said second layer, said inserts being compressible and having interior voids;

means for affixing said first layer and said second layer together whilst securing the inserts therebetween, and

wherein said insulation material includes two layers of inserts.

6. (Original) The insulation material in accordance with claim 5 wherein at least some of inserts of one layer are at an angle to inserts in a second layer.

7. (Original) The insulation material in accordance with claim 6 wherein the angle is 90°.

8. (Original) The insulation material in accordance with claim 5 which includes at least one intermediate layer of material of somewhat uniform thickness disposed between the two layers of inserts.

9. (Original) The insulation material in accordance with claim 6 which includes at least one intermediate layer of material of somewhat uniform thickness disposed between the two layers of inserts.

10. (Original) The insulation material in accordance with claim 5 which includes at least two intermediate layers of material of somewhat uniform thickness disposed between the two layers of inserts.

11. (Original) The insulation material in accordance with claim 1, wherein said layers of material are non-woven and comprise: batt, air laid fibers, melt blown fibers, spun-bond fibers or hydro-entangled fibers.

12. (Original) The insulation material in accordance with claim 8, wherein said layers of material are non-woven and comprise: batt, air laid fibers, melt blown fibers, spun-bond fibers or hydro-entangled fibers.

13. (Original) The insulation material in accordance with claim 9, wherein said layers of material are non-woven and comprise: batt, air laid fibers, melt blown fibers, spun-bond fibers or hydro-entangled fibers.

14. (Original) The insulation material in accordance with claim 10, wherein said layers of material are non-woven and comprise: batt, air laid fibers, melt blown fibers, spun-bond fibers or hydro-entangled fibers.